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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/964,793	09/28/2001	Takatsugu Nakazawa	P21331	2871
7055	7590	12/23/2004	EXAMINER	
GREENBLUM & BERNSTEIN, P.L.C.			SAGER, MARK ALAN	
1950 ROLAND CLARKE PLACE			ART UNIT	
RESTON, VA 20191			PAPER NUMBER	

3714

DATE MAILED: 12/23/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/964,793

Applicant(s)

NAKAZAWA ET AL.

Examiner

M. A. Sager

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 03 September 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-32 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-32 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

***Claim Rejections - 35 USC § 102***

1. Claims 1-3, 5, 6, 8-10, 12, 13, 15-17, 19, 20, 22- 24, 26, 27, and 29-31 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by *Dragon Quest IV* by Enix America, Inc (1990) as described in Dan Gonzales, *Dragon Quest IV (NES) Manual*, (June 4, 2003). *See, e.g., Gonzales, pp. 7-9.*

***Claim Rejections - 35 USC § 103***

2. Claims 4, 11, 18 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Dragon Quest IV* in view of Tanibuchi et al. U.S. Patent 6,475,084 B2 (Nov. 5, 2002). In regards to claims 4, 11, 18 and 25: *Dragon Quest IV* describes a video game program comprising structured data stored on a computer-readable storage medium for execution by a programmable processor wherein the processor generates an interactive game, including audio and video outputs, in response to player inputs received through computer input devices. The game teaches all the claims except displaying information of characters in the list on a subscreen including bodily powers and magical powers.

*Tanibuchi* discloses an analogous video game in allowing the replacement of characters. The game includes a subscreen for replacing characters and includes character names and abilities. *See fig. 10*. Notably, although *Tanibuchi* exemplifies the system as a baseball game, it suggests applying it to other types of games. *See col. 11:58-12:7*. In view of *Tanibuchi*, it would have been obvious to an artisan at the time of the invention to modify *Dragon Quest IV*, wherein a subscreen displays replacement characters possessing bodily and magical powers, to add the feature of displaying character information, including player bodily powers and magical powers, in a list on the subscreen. As suggested by *Tanibuchi*, providing information concerning

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replacement character's abilities enhances the game by permitting users to refer to information concerning the replacement characters. *See col. 12:61-67.*

3. Claims 7, 14, 21 and 28 is rejected under 35 U.S.C. 103(a) as being unpatentable over *Dragon Quest IV* in view of Yoshikawa et al., U.S. Patent 6,347,994 B1 (Feb. 19, 2002). *Dragon Quest IV* teaches all the features of the claims except displaying the action order of all the characters including player characters and enemy characters participating in the battle.

*Yoshikawa* discloses an analogous video game system in which characters in a battle can be changed or reordered. *See col. 11:50-57.* In particular regards to the claims, the game displays the action order of all characters. *See col. 11:37-48.* In view of *Yoshikawa*, it would have been obvious to an artisan at the time of the invention to modify the battle game described by *Dragon Quest IV*, wherein a plurality of characters participated in a battle, to display the action order of all the characters including player characters and enemy characters participating in the battle. As disclosed in *Yoshikawa*, the modification would enhance the game by indicating the order in which a battle will proceed after characters are changed or reordered. *See id.*

4. Claim 32 is rejected under 35 U.S.C. 103(a) as being unpatentable over *Dragon Quest IV* in view of Baker et al., U.S. Patent 6,106,399 (Aug. 22, 2000). *Dragon Quest IV* clearly teaches all the feature of the claim except a storage system that stores a program allowing a plurality of players to participate in the video game though a network.

*Baker* discloses an analogous multi-user, Internet role playing game system. It teaches that it was known in the art at the time of the invention to provide a storage system that stores a program allowing a plurality of players to participate in the video game though a network. *See col. 4:11-5:10.* In view of *Baker*, it would have been obvious to an artisan at the time of the

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invention to modify the *Dragon Quest IV*, wherein a plurality of characters participate, to add the feature of a storage system that stores a program allowing a plurality of players to participate in the video game through a network. As suggested by *Baker*, the modification would enhance the game by allowing multiple players to participate and interact in a constantly changing and expanding virtual world, and thereby provide a more entertaining game. *See col. 4:65-5:10.*

### ***Response to Arguments***

5. Applicant's arguments filed Sep 3, 2004 have been fully considered but they are not persuasive. Regarding claimed invention, as best understood, Gonzales review of *Dragon Quest IV*, *Dragon Quest IV* (pg 7-9) includes all claimed features/steps including to display a list of standby player characters not participating in the battle scene in a subscreen (see Wagon, pg 9) in response to a single step operation of a player character (pg 8 or 9) when a player character participating in said battle scene is awaiting a command input, to select any of the player characters displayed in the subscreen and to substitute an optionally selected player character and said player character awaiting the command input (pg 8-9). Essentially *Dragon Quest IV* includes a list of player characters not battling is displayed in response to a single step operation of a player (see Tactics and Member on pg 8, The Wagon and Switching Characters on pg 9) when a character in a battle is awaiting a command, sic. Also, *Dragon Quest IV* includes to select any of the player characters displayed in the subscreen in response to the operation of the player (pick any up to four characters in Switching Characters) and to substitute an optionally selected player character and said player character awaiting the command input, sic. *Dragon Quest IV*'s selection of an optional character from a list of characters to switch with a player

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character in the Fighting mode includes a single step operation, as broadly claimed and disclosed.

Applicant asserts that Gonzales [review of *Dragon Quest IV*] does not disclose or suggest a single step operation, as presently claimed, the examiner disagrees with Applicants interpretation of current claim breadth and of game reviewed by Gonzales. The claim language requires that the invention includes a single step operation be performed to display a list of standby characters not participating in the battle scene, but does neither require only a single step operation nor consist of a single step nor preclude multiple steps. Thus restating remarks from advisory mailed 8/13/04, incorporated herein, a multi-step operation includes a single step operation and thus the claim language fails to preclude *Dragon Quest IV*'s operation.

Further, Applicant asserts that Gonzales [review of *Dragon Quest IV*] does not disclose or suggest switching a player that is currently awaiting a command input (participating in battle), as presently claimed, the examiner disagrees with Applicants interpretation of current claim breadth and of game reviewed by Gonzales. Gonzales states during play of *Dragon Quest IV*, the team leaps into fighting mode when enemies approach (pg 7, Commands in the Fighting Mode), and thus at least a player character of the current team of players is in command input mode. The user may Switch Characters or Change Order to switch a team member outside with one inside of wagon (pg, 8-9). As best understood, a player character that is currently in fighting mode and awaiting a command from the list of commands in the Fighting Mode may be switched with a player character not participating in the battle scene (e.g. Wagon). Thus, claimed invention fails to preclude *Dragon Quest IV*'s operation.

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Also, Applicant assert that Gonzales [review of *Dragon Quest IV*] does not disclose or suggest displaying a list of standby characters, when a player character in battle is awaiting an input command, or switching the player character awaiting the command input, the examiner disagrees with Applicants interpretation of current claim breadth and of game reviewed by Gonzales. Essentially, a user may enter Switching Characters by selecting Tactics from Fighting Command Window. As best understood, a player character that is currently in fighting mode and awaiting a command from the list of commands in the Fighting Mode may be switched with a player character not participating in the battle scene, sic, when a user enters Switch under Tactics of Command Window so as to replace/swap/switch a player character currently in Fighting Mode with a player character from a list of player characters in a Wagon that are not participating in the battle scene. Thus, claimed invention fails to preclude *Dragon Quest IV*.

In addition, Applicants remark that Baker, Tanibuchi and Yoshikawa each do not disclose a single step operation and do not disclose a list of standby characters, this remark is not persuasive due to disclosure from Gonzales that *Dragon Quest IV* includes these features/steps and fails to consider the combination as a whole. The standard of patentability remains as what the combination taken as a whole at a time prior to the invention suggests to an artisan. In this instance, when the prior art is taken as a whole in combination with teachings of *Dragon Quest IV*, it suggests to an artisan at a time prior to the invention a program, method, apparatus or system to control a battle scene between a plurality of players and at least one enemy including a single step operation and a list of standby characters (*supra*), as broadly claimed.

Further, Applicants assert patentability of dependent claims based upon their dependency, thus, the statements above in response to Applicants assertions for claims 1, 8, 15, 22, and 29-31

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is incorporated herein for claims 2-7, 9-14, 16-21, 23-28 and 32. Finally, Applicants remarks are not persuasive in demonstrating that the structure/process of claimed invention differs from structure/process of *Dragon Quest IV* as reported by Gonzales.

It is reiterated that a single operation and single step operation is deemed same invention at least due to scope of claim being equivalent in that a single operation includes a single step operation as well as may alternatively include multiple step operation. Similarly, a single step operation includes a single step and may alternatively include multiple steps at least due to comprising. Also, a multi-step operation includes a single step operation. Thus scope is same.

### ***Conclusion***

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The references to *The Lost Vikings* by Blizzard Entertainment and *Norse by Norse West* (*The Lost Vikings* sequel) by Interplay each include switchable characters where a single key input, keypad 7 or 9, switches to another Viking character and thus considered pertinent.

7. This is a RCE of applicant's earlier Application No. 09964793. All claims are drawn to the same invention claimed in the earlier application and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the earlier application. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action in this case. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after



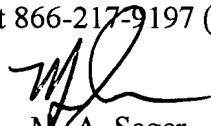
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the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no, however, event will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to M. A. Sager whose telephone number is 571-272-4454. The examiner can normally be reached on T-F, 0700-1730 hours.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Derris Banks can be reached on 571-272-4419. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



M. A. Sager  
Primary Examiner  
Art Unit 3714

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